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09/742,438	12/22/2000	Leandros Kontogouris	BEU/HK/KONTOGOURIS	8890
<div><div>7590</div><div>07/12/2007</div><div>BACON & THOMAS, PLLC 625 Slaters Lane, 4th Floor Alexandria, VA 22314-1176</div></div>				
			EXAMINER	
			DURAN, ARTHUR D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/742,438		KONTOGOURIS, LEANDROS	
	Examiner		Art Unit	
	Arthur Duran		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/14/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1, 2, 5-49 have been examined.

Response to Amendment

2. The Amendment filed on 12/14/06 is insufficient to overcome the prior rejection.

The Amendment filed on 12/14/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hamzy reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hamzy reference to either a constructive reduction to practice or an actual reduction to practice.

Please see the Response to Arguments section below for a more detailed explanation.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 8-11, 21, 22, 26-29, 35, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Hamzy (6,636,247).

Claim 1, 21, 35: Auxier discloses a method, system for ensuring that a user acknowledges an advertisement in exchange for access to an electronic address, service, or content, comprising: a computing or communications device of said user, said computing or communications device being connected to a provider of said address, service, or content, over a data communications network (Fig. 1);

software arranged to be loaded onto said computing or communications device and arranged to participate in presentation of an interactive banner advertisement to the user when said user indicates a desire to access said address, service, or content (col 3, lines 57-61; Fig. 3; col 2, lines 10-20),

wherein, upon presentation of the interactive banner advertisement, said user is permitted access to an address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Auxier further discloses that when said user indicates a desire to access said address, service, or content via the computer network, causing an advertising server to present an interactive banner advertisement to the user (Fig. 6),

that, upon presentation of the interactive banner advertisement, said user is permitted access to an address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Auxier further discloses targeting information and advertising to a specific user (col 3, lines 11-15)

Auxier does not explicitly disclose preventing access to said website, and continuing to prevent said access to said website so long as the user fails to submit the appropriate reply.

However, Hamzy discloses that the user requests access to a website, that a banner or advertisement is presented to the user that blocks access to the site the user requested, and that the user must enter an appropriate reply in order to gain access to the original website requested:

“(10) The present invention provides a system and method for displaying advertisements on the Internet in response to requests for Internet information from a specific website. In response to a request for a specific information available on the web, an advertisement associated with that web page is retrieved and displayed to the user. Within the display of the advertisement is embedded a randomly placed control function for proceeding from the advertisement to the web page of interest. Once the randomly placed control is activated by the user, the user requested information is displayed.

(11) The random or non-predictive control function can be the placement of buttons within the advertisement display. The control function can be a control key randomly placed within the advertisement. Another control function is asking a question that must be answered before proceeding to the web page of interest. A further control function according to the invention is to display the advertisement which is correlated to the particular web page for a predetermined time period before transferring the window containing the content or web page the user has selected” (col 2, lines 10-30).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hamzy's user requesting a website and then presenting and advertisement and blocking access to a user requested website until the user enters an appropriate reply to Auxier's interactive advertisement that can be placed before the user is given access to a site. One would have been motivated to do this in order to present advertising at a time that will attract attention from the user.

Additionally, Auxier discloses that the interactive banner advertisement provides information promoting a product or service (col 6, lines 22-26; col 1, lines 42-47; col 5, lines 35-42).

Auxier discloses that a user requests access to a webpage and that an interactive advertisement can be sent with the webpage data that was requested (Fig. 2).

Auxier further discloses tracking, monitoring, and recording advertisement delivery, interaction, success, etc (col 1, lines 27-60) and that users are targeted (col 3, lines 10-15).

Additionally, Auxier discloses that the user knows what website they will be sent to (Fig. 4, item 410, Advertiser Name) and that a user can be prevented from being given access to that requested website if the user does not offer an appropriate reply (col 8, lines 59-64).

Hence, Auxier discloses both sending an interactive advertisement with a webpage request that a user has made and Auxier discloses utilizing an advertisement that requires an appropriate user interaction or reply before a user is allowed to access a requested site (the Advertiser/Merchant site).

Additionally, Auxier discloses that the address, service, or content is provided by a server or broadcaster that is distinct from the advertising server (Fig. 1).

Claim 2: Auxier and Hamzy disclose a method as claimed in claim 1, and Auxier further discloses that said electronic address, service, or content is an Internet uniform resource locator (col 1, lines 33-35).

Claim 22, 36: Auxier and Hamzy disclose a method as claimed in claim 1, and Auxier further discloses that said electronic address, service, or content is content provided by a server connected to the Internet (col 1, lines 10-15).

Claim 8, 26: Auxier and Hamzy disclose a method as claimed in claim 7, and Auxier further discloses that a provider of the electronic address, service, or content downloads said client software to the user's computing device when said user requests access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

Claim 9, 27: Auxier and Hamzy disclose a method as claimed in claim 8. Auxier further discloses that said client software is resident on said user's computing device before said user requests access to said electronic address, service, or content (col 4, lines 43-53; col 2, lines 10-15). Auxier further discloses the reception of special code that allows banner advertisements to be interacted with (col 4, lines 43-53) and that the special code can be stored on the client computer (col 2, lines 10-15). Therefore, Auxier implies that the special code can reside on the client computer before future requests for the user will make.

Claim 10, 28: Auxier and Hamzy disclose a method as claimed in claim 8, and Auxier further discloses that said client software is resident on a server located at or that provides the electronic address, service, or content (Fig. 3; col 2, lines 9-11). Note that regardless of where

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the client software runs from, the client software is resident on the server before the client software is downloaded from the server to the client.

Claim 11, 29: Auxier and Hamzy disclose a method as claimed in claim 1, and Auxier further discloses that said client software connects said user's computing device to a server located at or that provides said electronic address, service, or content, and wherein said server carries out said steps of presenting said interactive banner advertisement and permitting access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

4. Claim 7, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Hamzy (6,636,247) in view of Griffiths (6,286,045).

Claim 7, 25: Auxier and Hamzy disclose a method as claimed in claim 1.

Auxier discloses an interactive banner advertisement and permitting access to said service only if the user submits an appropriate reply to the banner advertisement as disclosed in the independent claim.

Auxier does not explicitly disclose that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement.

However, Griffiths discloses banner advertisements (col 3, lines 13-21). Griffiths further discloses that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement (Fig. 1; Fig. 3; col 4, lines 17-29). Griffiths further discloses taking measures for more efficient delivery of advertising over a network (col 1, lines 9-15).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Griffiths utilization of proxy servers with banner advertisements to Auxier's banner advertisements delivered over a network. One would have been motivated to do this for more efficient deliver of advertising over a network.

5. Claims 5, 6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37, 38, 39, 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Hamzy (6,636,247) in view of Slotznick (6,011,537).

Claim 42, 44, 46, 47: Auxier and Hamzy disclose a banner advertisement, comprising: promotional text arranged in a box on a display screen of a computing or communications device and presented to a user of the computing or communications device who requests access to an electronic address, service, or content over a network (Fig. 4; col 3, lines 57-61); and area associated with said box for permitting entry of a response to said text (col 8, lines 60-65; Fig. 4), wherein said banner advertisement prevents access to an electronic address, service, or content unless said response to said text is entered by the user (col 8, lines 60-65; Fig. 4).

Auxier further discloses that said banner advertisement is in a multimedia format (col 2, lines 5-9).

Auxier does not explicitly disclose that the promotional text is presented when the user requests access to content over a network.

However, Slotznick disclose that the promotional text is presented when the user requests access to content over a network (col 4, lines 49-56).

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Slotznick further discloses that said area includes a pop-up menu (col 3, lines 34-36).

Slotznick further discloses sounds and multimedia (col 1, lines 53-57; col 1, lines 61-64; col 2, lines 12-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's presenting the promotion when the user requests content to Auxier's game before the user is permitted to access the content. One would have been motivated to do this because some users may not want to request the primary information or content if they knew that had to see promotional information first.

Auxier further discloses that when said user indicates a desire to access said address, service, or content via the computer network, causing an advertising server to present an interactive banner advertisement to the user (Fig. 6),

that, upon presentation of the interactive banner advertisement, said user is permitted access to an address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Auxier further discloses targeting information and advertising to a specific user (col 3, lines 11-15)

Auxier does not explicitly disclose preventing access to said desired address, service, or content, and continuing to prevent said access to said desired address, service, or content so long as the user fails to submit the appropriate reply.

However, Hamzy discloses that the user requests access to a website, that a banner or advertisement is presented to the user that blocks access to the site the user requested, and that the user must enter an appropriate reply in order to gain access to the original website requested:

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“(10) The present invention provides a system and method for displaying advertisements on the Internet in response to requests for Internet information from a specific website. In response to a request for a specific information available on the web, an advertisement associated with that web page is retrieved and displayed to the user. Within the display of the advertisement is embedded a randomly placed control function for proceeding from the advertisement to the web page of interest. Once the randomly placed control is activated by the user, the user requested information is displayed.

(11) The random or non-predictive control function can be the placement of buttons within the advertisement display. The control function can be a control key randomly placed within the advertisement. Another control function is asking a question that must be answered before proceeding to the web page of interest. A further control function according to the invention is to display the advertisement which is correlated to the particular web page for a predetermined time period before transferring the window containing the content or web page the user has selected” (col 2, lines 10-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hamzy's user requesting a website and then presenting and advertisement and blocking access to a user requested website until the user enters an appropriate reply to Auxier's interactive advertisement that can be placed before the user is given access to a site. One would have been motivated to do this in order to present advertising at a time that will attract attention from the user.

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Claim 5, 6, 12, 14, 20, 23, 24, 30, 32, 37, 38, 39, 48, 49: Auxier and Hamzy disclose a method as claimed in claim 1 and Auxier, Hamzy, and Slotznick disclose an advertisement as in claim 42.

Auxier discloses television and the Internet (col 1, lines 10-15; col 1, lines 17-21).

Auxier does not explicitly disclose that said electronic address, service, or content provided by a broadcaster on an interactive digital television network.

Auxier does not explicitly disclose an cellular or wireless network.

However, Slotznick discloses that said electronic address, service, or content provided by a broadcaster on an interactive digital television network (col 5, lines 24-28; col 7, lines 35-42).

Slotznick further discloses a wireless network and a cellular network (col 18, lines 25-32).

Slotznick further discloses the utilization of cookies (col 15, lines 40-47).

Slotznick further discloses a plug-in to an Internet browser installed on said user's computing device (col 31, lines 53-55; col 32, lines 1-14).

Slotznick further discloses that said electronic address, service, or content is a subscription-based service (col 16, lines 18-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's interactive television, cellular, wireless network, and cookies to Auxier's Internet and television. One would have been motivated to do this because interactive television is an obvious device that combines the Internet and television and would appeal to many users and the Internet is obviously manifested on different types of network for the convenience of the user and cookies are a standard and convenient way to store information

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on a user's device. Furthermore, plug-ins are standard Internet software tools and a subscription service is a standard and convenient way for a user to receive information.

Claim 13, 31: Auxier, Hamzy and Slotznick disclose the method as claimed in claim 12.

Auxier further discloses downloading software (col 2, lines 9-20) and that software is necessary before gaining access to said electronic address, service, content and that that software is retrieved (col 4, lines 45-50; Fig. 3).

Auxier does not explicitly disclose that the software is a plug-in or that the download occurs when the user requests access to the content.

However, Slotznick discloses a plug-in to an Internet browser installed on said user's computing device (col 31, lines 53-55; col 32, lines 1-14).

Slotznick further discloses downloading required software to the client when the client requests access to the electronic address, service, or content (col 12, lines 40-52).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's plug-in downloaded when the user requests content to Auxier's necessary software which is retrieved to the client device before accessing the content and Auxier's software which is downloaded to the client device. One would have been motivated to do this because a plug-in is a standard Internet software tool and downloading required software when a user requests access to content is a convenient time to download software to a client.

Claim 15, 19: Auxier, Hamzy and Slotznick disclose a method as claimed in claim 14.

Auxier further discloses targeting advertisements to the user (col 3, lines 10-13).

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Auxier further discloses collecting user provided information (col 2, lines 39-42; col 7, lines 17-23).

Auxier does not explicitly disclose the steps of identifying said user and determining whether said user has a subscription to said service, and wherein said step of presenting said interactive banner advertisement is carried out if said user does not have a subscription to said service.

However, Slotznick discloses the steps of identifying said user and determining whether said user has a subscription to said service, and wherein said step of presenting said interactive banner advertisement is carried out if said user does not have a subscription to said service (col 16, lines 9-29).

Slotznick further discloses that said interactive banner advertisements are selected based on information stored on said user's computing device and information provided by said user (col 16, lines 9-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's different information depending on the type of user to Auxier's targeted user. One would have been motivated to do this because targeting a user implies sending that user different information depending upon who the user is.

Claim 43, 45: Auxier, Hamzy and Slotznick disclose an advertisement as claimed in claim 43.

Auxier further discloses that said electronic address, service, or content is content provided by a server connected to the Internet (col 1, lines 10-15).

Auxier further discloses a hyperlink to a website of said advertiser (col 1, lines 33-35).

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6. Claim 16-18, 33, 34, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Hamzy (6,636,247) in view of Slotznick (6,011,537) in view of Eggleston (6,061,660).

Claim 16: Auxier and Hamzy disclose a method as claimed in claim 1.

Auxier further discloses targeting a user and that a user can be a repeat user (col 3, lines 10-14; col 4, lines 45-54).

Auxier further discloses that the user can win (col 6, lines 25-30).

Auxier further discloses that the user can win prizes in the form of the merchants services (col 6, lines 25-30).

Auxier does not explicitly disclose tallying credits or a subscription service.

However, Slotznick discloses a subscribing user or paying user (col 16, lines 17-22).

Slotznick further discloses that presenting said interactive banner advertisement can be based on the status and history of the user including whether or not the user has a subscription to said service (col 16, lines 9-29). Slotznick further discloses that whether an ad is shown or not can be controlled (col 16, lines 20-25).

Eggleston discloses tallying credits so that a user can receive a prize (col 13, lines 50-67) including the services of a merchant (col 1, lines 33-35; col 13, lines 60-62) and that the credits are tallied in response to a correct answer (col 26, lines 53-58; col 7, lines 45-50) and that the user has an account with credits in it (col 16, lines 54-56).

Eggleston further discloses that a user can be awarded for watching advertising (col 1, lines 37-45).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's subscription service and Slotznick's showing different advertisements to a user based upon the user status and history and Eggleston's tallying of points won as a status about a user to Auxier's targeted user and receiving merchant services as a prize for correct answers. One would have been motivated to do this because a subscription service is an obvious merchant service and tallying prize totals allows tracking the user for more advanced targeting over the longer term.

Claim 17, 18, 33, 34, 40, 41: Auxier and Hamzy disclose a method as claimed in claim 1.

Auxier further discloses targeting a user and that a user can be a repeat user (col 3, lines 10-14; col 4, lines 45-54).

Auxier further discloses that the user can win (col 6, lines 25-30).

Auxier further discloses that the user can win prizes in the form of the merchants services (col 6, lines 25-30).

Auxier does not explicitly disclose tallying credits or a subscription service.

However, Slotznick discloses a subscribing user or paying user (col 16, lines 17-22).

Slotznick further discloses that presenting said interactive banner advertisement can be based on the status and history of the user including whether or not the user has a subscription to said service (col 16, lines 9-29). Slotznick further discloses that whether an ad is shown or not can be controlled (col 16, lines 20-25).

Eggleston discloses tallying credits so that a user can receive a prize (col 13, lines 50-67) including the services of a merchant (col 1, lines 33-35; col 13, lines 60-62) and that the credits

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are tallied in response to a correct answer (col 26, lines 53-58; col 7, lines 45-50) and that the user has an account with credits in it (col 16, lines 54-56).

Eggleston further discloses that a user can be awarded for watching advertising (col 1, lines 37-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's subscription service and Eggleston's tallying of points won so that a user can receive a merchant service to Auxier's targeted user and receiving merchant services as a prize for correct answers. One would have been motivated to do this because a subscription service is an obvious merchant service and tallying prize totals allows tracking the user for more advanced targeting over the longer term.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 5-49 have been considered but are not found persuasive.

The Amendment filed on 12/14/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hamzy reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hamzy reference to either a constructive reduction to practice or an actual reduction to practice.

Examiner notes that the evidence presented in the 37 CFR 1.131 places the stated date of conception to December 23, 1999. Hence, the Applicant has stated that the date of conception December 23, 1999 and the Applicant must show diligence from before January 31, 2000 (the

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priority date of the Hamzy reference) thru to the date of construction reduction to practice or, in this case, filing which is Applicant's filing date of December 22, 2000.

Examiner notes that Applicant must demonstrate diligence for nearly 11 months.

Examiner note that the MPEP at section 715.07(a) and 2138.06 states detailed criteria for demonstrating diligence. The Applicant must present evidence for affirmative acts that demonstrate daily diligence.

The December 14, 2006 Exhibits related to the 37 CFR .1.131 affidavit leaves significant time portions before the constructive reduction to practice date of December 22, 2000 without demonstrated diligence. Examiner notes that "THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES" (MPEP 2138.06). Please see the MPEP citations below.

Also, Examiner notes that "WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY RELATED TO THE REDUCTION TO PRACTICE

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue" (MPEP 2138.06). Examiner notes that many of the Exhibits are in Greek. Also, many of the Exhibits are third party newspaper articles that are of uncertain significance. Also, some of the Exhibits are business cards without dates. Also, Examiner notes that the flowchart/spreadsheet entitled "evidence_of_diligence.pdf" lists evidence which is not directly related to reduction to practice. Applicant seems to have listed a course syllabus. However, the work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. It is not sufficient that the activity

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relied on concerns related subject matter. Hence, the evidence of diligence is not directly related to the reduction to practice of the claimed invention.

Hence, Applicant's 37 CF 1.131 affidavit dated 12/14/2006 has not demonstrated due diligence from before January 31, 2000 thru to December 22, 2000. Specifically, Applicant has not demonstrated that "THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES" or that "WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY RELATED TO THE REDUCTION TO PRACTICE" (MPEP 2138.06).

Therefore, the Applicant has not sufficiently demonstrated diligence and the 37 CFR 1.131 affidavit dated 12/14/2006 is ineffective.

Therefore, the Hamzy reference is valid prior art. Therefore, the Rejection above remains valid.

The following quotes are from the MPEP 2138.06:

2138.06 [R-1] "Reasonable Diligence"

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re

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Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959)

WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY RELATED TO THE REDUCTION TO PRACTICE

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. Naber v. Cricchi, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). >See also Scott v. Koyama, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) “The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter.” Gunn v. Bosch, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973)

715.07.III.

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

715.07(a) Diligence

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Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established.

Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970).

2138.06 [R-1] "Reasonable Diligence"

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE
ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not

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enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964)

(statement that the subject matter “was diligently reduced to practice” is not a showing

but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re*

Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131

issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959)

(Less than 1 month of inactivity during critical period. Efforts to exploit an invention

commercially do not constitute diligence in reducing it to practice. An actual reduction to

practice in the case of a design for a three-dimensional article requires that it should be

embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d

986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be

specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative

acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter.

1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). . . *Griffith v.*

Kanamaru, 816 F.2d 624, 2

USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for

inactivity including vacation extended by ill health and daily job demands, and held lack of

university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535

F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for

testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ

318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other

projects is generally not an acceptable excuse although there may be circumstances

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creating exceptions);

WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY
RELATED TO THE REDUCTION TO PRACTICE

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). >See also *Scott v. Koyama*, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) “The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter.” *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973) (An actual reduction to practice of the invention at issue which occurred when the inventor was working on a different invention “was fortuitous, and not the result of a continuous intent or effort to reduce to practice the invention here in issue. Such fortuitousness is inconsistent with the exercise of diligence toward reduction to practice of that invention.” 181 USPQ at 761. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence);

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
Art Unit 3622

5/23/2007